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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91219959
Party	Defendant Fitness Publications, Inc.
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Universal Protein Supplements)
Corporation dba Universal Nutrition,)
)
Opposer,)
)
vs.)
)
Fitness Publications, Inc.,)
)
Applicant.)



Filing Date: August 01, 2013

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II. FACTUAL BACKGROUND

This proceeding concerns the use and registration of images of bodybuilders in conjunction with the sale of nutritional supplements used by bodybuilders.

Petitioner Universal uses a generic bodybuilder image to market its products to bodybuilders much as a baby food or dog food supplier would use an image of a baby or dog in marketing its products.

Fitness, which is owned by Arnold Schwarzenegger, also uses a bodybuilder image for nutrition products sold to bodybuilders by its licensee MusclePharm Corporation. By contrast to the Universal bodybuilder, the image used by Fitness is an actual silhouette image of Arnold Schwarzenegger. As explained in detail in the counterclaim, Mr. Schwarzenegger is a world famous bodybuilder and, directly and through his company Fitness and its licensees, remains actively involved in the bodybuilding community through a variety of activities including Arnold Classic bodybuilding and sports events.

Illustrative examples of the nutritional supplement products involved in this proceeding are shown below:



See www.universalusa.com and www.arnold.com.

Universal has asserted that the registration of the silhouette of Arnold Schwarzenegger in conjunction with nutritional supplements used by bodybuilders would cause a likelihood of confusion with respect to Universal's trademarks. Initially, Universal brought this action based upon a single registration of its bodybuilder standing alone. After Fitness filed a counterclaim to cancel that registration, Universal filed an amended petition to include registrations of the word UNIVERSAL with the bodybuilder image embedded as the letter "I". In defense, Fitness has denied that any likelihood of confusion would exist, because, among others reasons, the image of Arnold Schwarzenegger would be recognized by the actual and potential consumers of the parties' products as him. In addition,

Fitness has challenged the validity of Universal's registration of its generic bodybuilder design standing alone.

In its motion to strike, Universal has asked the Board to strike references in the counterclaim to Fitness' rights in the term ARNOLD and Mr. Schwarzenegger's name and to strike the entire Affirmative Defenses section of Fitness' Answer.

III. LEGAL STANDARD

The function of a motion to strike is "to avoid the expenditure of time and money that must arise from litigating spurious issues by dispensing with those issues prior to trial." *Whittlestone, Inc. v. Hand-Craft Co.*, 618 F.3d 970, 973 (9th Cir. 2010). "Motions to strike are not favored, and matter will not be stricken unless it clearly has **no bearing** upon the issues in the case." T.B.M.P. § 506.01 (emphasis added). Further, the moving party must demonstrate some form of prejudice arising out of the objectionable matter:

[B]ecause federal judges have made it clear . . . that Rule 12(f) **motions to strike** [matter as redundant or immaterial] **are not favored, often being considered purely cosmetic or 'time wasters,' . . . they should be denied** unless the challenged allegations have no possible relation or logical connection to the subject matter of the controversy **and** may cause some form of significant prejudice . . .

5C CHARLES ALAN WRIGHT & ARTHUR R. MILLER, FED. PRACTICE & PROCEDURE §§ 1380 at 394, 1381 at 416, 1382 at 436 (3d ed. 2004) (citations omitted) (emphasis added); *see also, Canadian St. Regis Band of Mohawk Indians v. New*

York, 278 F. Supp. 2d 313, 325 (N.D.N.Y. 2003) (“to prevail on this motion to strike . . . [the moving parties] have the burden of showing the absence of factual questions; the absence of substantial questions of law, *and* that they will be prejudiced by the inclusion of the affirmative defenses”).

Universal’s motion fails to meet the legal standard. Far from raising “spurious issues”, Fitness’ allegations are well-pleaded and relevant to this proceeding.

IV. ARGUMENT

A. Applicant’s Allegations Regarding the Identity and Persona of Its Marks are Relevant and Material to Its Section 2(a) Counterclaim and Universal’s Section 2(d) Claim.

Universal has asked the Board to strike the allegations concerning Fitness’ purported right in the “ARNOLD” marks and Mr. Schwarzenegger’s name.

Universal argues the allegations are not relevant to the likelihood of confusion claim raised by Universal but conveniently neglects to discuss any of the thirteen du Pont factors, which include a variety of marketplace factors involving interaction of the marks at issue in the relevant marketplace and a general catch-all factor of “any other established fact probative of the effect of use”. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *In re Allegiance Staffing*, Serial No. 85663950 (July 9, 2015) [precedential](relying on thirteenth factor).

Universal's argument also inexplicably ignores the fact that these allegations are part of the counterclaims. In one of those counterclaims, Fitness alleges in the alternative that, if any confusion exists between the Universal bodybuilder design and the Fitness bodybuilder design as Universal alleges, that confusion could only exist because the Universal design is a close approximation of Schwarzenegger's likeness and/or identity and therefore that Universal's design registration should be cancelled for creating a false association with Arnold Schwarzenegger. Universal has not challenged that claim on the merits.

The initial and critical requirement of a Section 2(a) false association claim is that the name (or an equivalent thereof) claimed to be appropriated by another must be associated with a particular personality or 'persona.' *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 1376-1377, 217 U.S.P.Q. (BNA) 505 (Fed. Cir. 1983). In support of its Section 2(a) counterclaim, Fitness alleges that, due to Mr. Schwarzenegger's fame and reputation in the world of bodybuilding, when Universal's mark—which if Universal is right consists of a silhouette of a bodybuilder approximating Mr. Schwarzenegger's likeness and identity—is used on bodybuilding-related goods and services, a connection between, on the one hand, Universal and, on the other hand, Schwarzenegger and/or Fitness, would be presumed. (Answer and Counterclaim, ¶ 39).

Earlier this year, the Board clarified the relevant analysis in Section 2(a) cases involving celebrities:

The evidence reflects that Kate Middleton is a celebrity. That means her identity has value which the § 2(a) false suggestion refusal is intended to protect. Therefore, it is the right of publicity basis for the false suggestion of a connection refusal that applies in this case.

In re Nieves & Nieves LLC, 2015 TTAB LEXIS 12, *13, 113 U.S.P.Q.2D (BNA) 1639, 1644, (T.T.A.B. Jan. 30, 2015). Applying the same analysis here, the relevance and import of Fitness’ allegations concerning the celebrity of Arnold Schwarzenegger are undeniable.

Universal’s motion seeks to excise from Fitness’ pleading the core allegations that establish Fitness’ rights in Mr. Schwarzenegger’s name and likeness, including as protected in several registrations and pending applications. (Counterclaim, ¶¶ 21-22, 25-26). Far from being irrelevant or unnecessarily complicating this proceeding, each of these allegations contain facts, which, if proved, establish that Fitness (with permission) used Mr. Schwarzenegger’s unmistakably famous name and likeness in a manner such that they are associated with Fitness. As such, Universal’s motion fails to establish either the absence of factual questions or the absence of substantial questions of law.

Because Universal cannot establish that the allegations “have no possible relation or logical connection to the subject matter of the controversy”, Universal’s claim that it will be “greatly prejudiced” by the inclusion of these allegations must

also fail. 5C CHARLES ALAN WRIGHT & ARTHUR R. MILLER, FED. PRACTICE & PROCEDURE § 1382 at 436 (3d ed. 2004) (citing, *inter alia*, *Hanna v. Lane*, 610 F. Supp. 32, 34 (N.D. Ill. 1985) (“courts ordinarily will not strike matters unless it both has no relevance to the subject matter of the litigation and is prejudicial to the objecting party”)).

Universal’s motion should be denied for the additional reason that the motion fails to identify the specific language that it seeks to have the Board strike.

Accordingly, and especially in light of the *B&B Hardware* decision, Universal’s motion to strike allegations with respect to Fitness’ rights in the term ARNOLD and Mr. Schwarzenegger’s name must be denied.

B. Applicant’s Affirmative Defenses Are Relevant And Not Unfairly Prejudicial.

As described above, motions to strike are broadly disfavored as “purely cosmetic” and “time-wasters,” and, accordingly, should only be granted only if the subject allegations are both wholly irrelevant *and* prejudice the moving party. *See also* TBMP § 506.01 (“the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party”).

Moreover, with respect to allegations cast as “affirmative defenses”, the Board has recognized that respondents have a right to include amplifying

allegations in their answers that help explain their defense whether or not those allegations rise to the level of an “affirmative defense” in the technical sense:

“An answer may include affirmative assertions that, although they may not rise to the level of an affirmative defense, nevertheless state the reasons for, and thus amplify, the defendant’s denial of one or more of the allegations of the complaint. These amplifications of denials, whether referenced as ‘affirmative defenses’, ‘avoidances’, affirmative pleadings’, or ‘arguments,’ are permitted by the Board because they serve to give the plaintiff fuller notice of the position which the defendant plans to take in defense of its right to registration.”

T.B.M.P. § 311.02(d).

In its motion, Universal has asked the Board to strike the entire Affirmative Defenses section of Fitness’ answer, which consists in its entirety of the following three short paragraphs:

11. The Fitness Silhouette Mark is an actual likeness of Arnold Schwarzenegger, who is famous internationally as a professional bodybuilder. The likeness of Arnold Schwarzenegger is inherently distinctive. The average consumer is likely to associate the Fitness Silhouette Mark with Arnold Schwarzenegger.

12. Fitness Publications incorporates the allegations of the counter-claims referenced below.

13. Fitness Publications hereby reserves the right to amend its Answer to raise additional affirmative defenses as they become available or apparent to Fitness Publications through discovery in this matter or otherwise.

(Answer, p. 6).

Universal has not shown that these allegations are wholly irrelevant and causing unfair prejudice to Universal. Thus, the motion must be denied.

1. Applicant's First Affirmative Defense Paragraph is Permissible and Should Not Be Stricken.

Universal asserts that the following sentence “does not clarify in relation to what goods and/or services [the mark] is distinctive” and , therefore, fails to provide “fair notice of the factual basis for its defense” (Motion at 4-5):

The Fitness Silhouette Mark is an actual likeness of Arnold Schwarzenegger, who is famous internationally as a professional bodybuilder. The likeness of Arnold Schwarzenegger is inherently distinctive. The average consumer is likely to associate the Fitness Silhouette Mark with Arnold Schwarzenegger.

(Answer, at ¶12) (emphasis added).

Having achieved international fame as an actor, professional bodybuilder, former governor of California, and businessman, Mr. Schwarzenegger's likeness is inherently distinctive if used in connection with *any* good or service—such is the nature of an inherently distinctive individual likeness. *See, e.g., Phila. Orchestra Ass'n v. Walt Disney Co.*, 821 F. Supp. 341, 349-50 (E.D. Pa. 1993) (“Individuals and groups hold the right to control the commercial exploitation of their inherently distinctive names and likenesses, which right is referred to as their ‘right of publicity.’ A defendant violates a plaintiff's right of publicity by appropriating its valuable name or likeness, without authorization, to defendant's commercial advantage.”) (citation omitted).

Universal is undeniably on notice as to Applicant's claim of inherent distinctiveness in the Fitness Silhouette Mark, *at a minimum*, with respect to the

goods included in the application forming the basis of this opposition proceeding, namely, “dietary and nutritional supplements”. In sum, Universal’s allegations amount to nothing but blatant “time-wasting” and should be denied as such by the Board.

2. Applicant’s Second Affirmative Defense Paragraph Referencing Applicant’s Counterclaims Is Permissible.

Universal complains that Fitness’ single sentence under the heading “Affirmative Defenses” incorporating by reference the counterclaims to cancel Universal’s cited registration is “redundant” and incorrectly characterizes that single sentence as unnecessarily repeating all the allegations. The reason that the affirmative defense of invalidity of the cited registration appears under the label counterclaim is because of the TTAB rule that requires that an affirmative defense attacking the validity of a cited registration be raised (with certain limited exceptions) as a counterclaim with payment of the applicable fee. Trademark Rule 2.106. But, even then, pursuant to Trademark Rule 2.106(b)(2), the counterclaim is to be pleaded with or as *part of the answer*.

Referencing the defense raised by the counterclaims in one sentence under the heading “Affirmative Defenses”, even if arguably redundant, is a permissible amplification of Fitness’ defense of the allegations in the petition by emphasizing that Fitness is raising affirmative defenses in the counterclaim section. See T.B.M.P. § 311.02(d). In any event, the challenged sentence is not wholly

irrelevant and does not unfairly prejudice Universal. Accordingly, the motion to strike should be denied.

3. Applicant's Third Affirmative Defense Paragraph Is A Customary Boilerplate Reservation Of Possible Unknown Defenses That Is Not Wholly Irrelevant And Does Not Unfairly Prejudice Universal.

Universal complains that Fitness' third sentence, putting Universal on notice that Fitness is reserving its right to "amend its Answer to raise additional affirmative defenses as they become available or apparent to Fitness Publications through discovery", does not provide fair notice to Universal of reserved defenses. That position is nonsense. Fitness has not tried to reserve undisclosed known defenses as Universal seems to be implying. The statement plainly states that Fitness reserves the right to amend if and when new affirmative defenses become "available or apparent". If such new defenses become known to Fitness during discovery, Fitness will pursue an amendment as parties are permitted to do under the Trademark Rules.

Although perhaps an unnecessary amplification of Fitness' defense, the third "affirmative defense" is nonetheless a permissible amplification, see T.B.M.P. § 311.02(d), that puts Universal on notice that Fitness will be looking for additional defenses during discovery. This type of one sentence reservation statement has become customary in pleading practice and causes no harm or prejudice to petitioners. Universal has not shown that the statement is wholly irrelevant or that

it is suffering any unfair prejudice. Accordingly, Universal's motion to strike must be denied.

V. CONCLUSION

For the foregoing reasons, Universal's motion to strike should be denied in its entirety.

Dated: July 17, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE AND MAILING

It is hereby certified that a copy of the foregoing OPPOSITION TO MOTION TO STRIKE is being deposited with the United States Postal Service, first-class postage prepaid, in an envelope addressed to:

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Executed this 17th day of July 2015 at Los Angeles, California.

/David W. Grace/
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